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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/518,533	12/30/2004	Markus Oles	263593US0XPCT	9525

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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

WALTERS JR, ROBERT S

ART UNIT	PAPER NUMBER
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4172

NOTIFICATION DATE	DELIVERY MODE
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08/05/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/518,533	Applicant(s) OLES ET AL.	
	Examiner ROBERT S. WALTERS JR	Art Unit 4172	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 1-8 and 13-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/30/2004, 3/14/2005, 9/22/2005, 2/21/2006,</u> | 6) <input type="checkbox"/> Other: _____ |
| <u>3/28/2006</u> | |

DETAILED ACTION

Status of Application

Claims 1-24 are pending, claims 1-8 and 13-24 are withdrawn as being drawn to a non-elected invention, and claims 9-12 are presented for examination.

Election/Restrictions

Applicant's election with traverse of claims 9-12 in the reply filed on 7/10/2008 is acknowledged. The traversal is on the ground(s) that the examiner has not proven that the claims are independent and distinct nor has the examiner shown proof of a serious search burden. This is not found persuasive because this is a national stage application and the examiner must only demonstrate that the inventions lack unity. In this case, the technical feature which unites all the claims is the aqueous surfactant-free suspension and the examiner has demonstrated that this fails to become a special technical feature by pointing to Spenleuhauer et al. (U.S. Pat. No. 5766635). Therefore, the claims lack unity of invention and restriction for examination purposes is proper.

The requirement is still deemed proper and is therefore made FINAL.

Specification

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

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As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase “Not Applicable” should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC.
- (f) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.
- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A “Sequence Listing” is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required “Sequence Listing” is not submitted as an electronic document on compact disc).

The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code, see page 11. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

Claim Objections

Claims 9 is objected to because of the following informalities: This claim needs to be rewritten into independent form, as a result of the restriction requirement. Appropriate correction is required.

Claim Rejections - 35 USC § 102/103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 9-12 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Sekutowski et al. (U.S. Pat. No. 6156327).

Regarding claim 9, Sekutowski teaches an aqueous surfactant-free suspension comprising methanol, water, and a hydrophobic (column 4, lines 41-42), nanostructured particle, wherein the suspension comprises at least 50.01% by weight of water (column 8, line 64-column 9, line 1 and the hydrophobic particles consist of TRANSLINK 77, talc, and other particles with hydrophobicity imparted by a treatment, see Table III). It should be noted that the term nanostructured particle is a broad term and would encompass any ridge or indentation in the nanoscale range on a particle and does not limit the claim to structures having a defined nanoscale texture on the surface of the particle. Sekutowski teaches that the particles that are preferably used are about 1 micron or less, and these particles, being minerals or treated minerals, would inherently not have a perfectly flat texture and would have imperfections that would correspond to ridges and indentations on the nanoscale range, thus reading on the claimed term of nanostructured particle. It should be noted that even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product

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in the product by process claim is the same as or obvious from a product of the prior art, as in this case, the claim is unpatentable even though the prior product was made by a different process, in this case the mixing step is not explicitly stated by Sekutowski.

Regarding claim 10, Sekutowski teaches a suspension containing 0.1 to 2.5% by weight of the hydrophobic particles (see Treatment 3 of Example 5, containing 12.5 pounds of hydrophobic particle suspended in 2 gallons of methanol and 100 gallons of water).

Regarding claims 11-12, Sekutowski teaches the suspension comprising from 0.1 to 49.98 % by weight of alcohol and at least 60 % by weight of water (see column 8, line 64-column 9, line 1, the composition containing 5 grams of particles, 10 mL methanol, and brought to 100 mL with deionized water).

Pertinent Prior Art

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Vrba (U.S. Pat. No. 5122518)

Fessi et al. (U.S. Pat. No. 5118528)

Conclusion

Claims 1-24 are pending.

Claims 1-8 and 13-24 are withdrawn as being drawn to a non-elected invention.

Claims 9-12 are rejected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT S. WALTERS JR whose telephone number is (571)270-5351. The examiner can normally be reached on Monday-Thursday, 6:30am to 5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vickie Kim can be reached on (571)272-0579. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ROBERT S. WALTERS JR/

July 22, 2008

Examiner, Art Unit 4172

/Alain L. Bashore/

Primary Examiner, Art Unit 1792